

REMARKS

Claims 8 to 82 (which were previously withdrawn based on a prior restriction requirement) and claims 83 to 85 and 87 to 90 are canceled without prejudice, claims 91 to 102 are added, and therefore claims 91 to 102 are now pending.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

With respect to paragraph four of the Final Office Action, claims 83 to 90 were rejected under the first paragraph of 35 U.S.C. § 112 as to the written description requirement.

While these rejections were previously overcome in the Amendment After Final previously filed, to facilitate matters, claims 83 to 85 and 87 to 90 are canceled without prejudice (claim 86 was previously canceled), since new claims 91 to 102 have been presented. It is therefore respectfully requested that these rejections be withdrawn.

With respect to paragraph nine (9), claims 83 to 90 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,592,921 (“Rehbichler”).

Claim 86 was previously canceled without prejudice to facilitate matters.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the prior Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Final Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

While these rejections may not be agreed with (see the Amendment After Final previously filed), to facilitate matters, claims 83 to 85 and 87 to 90 are canceled without prejudice (claim 86 was previously canceled), since new claims 91 to 102 have been presented. It is therefore respectfully requested that these rejections be withdrawn.

New claims 91 to 102 do not add any new matter and are supported by the specification (and correspond to the claims in the corresponding European case).

Claim 91 is to a method of activating an electromagnetic consumer having a movable element, the method including ascertaining a switching instant within a time window, at which the movable element reaches a certain position, and specifying a duration of the time window so that a current which flows through the consumer during the time window does not exceed a threshold value, *in which the duration of the time window starting from a starting value is increased if the current is smaller than the threshold value, and in which the duration of the time window is decreased if the current is greater than the threshold value.*

In contrast the “Rehbichler” reference purportedly concerns a method and a device for actuating an electromagnetic load for influencing metering of fuel in an internal combustion engine. The electromagnetic load is connected with a switch that is supplied with an actuation signal. For identification of a switching time of the electromagnetic load, a parameter which characterizes the actuation signal is evaluated. (Abstract, lines 1 to 7). Furthermore, the “Rehbichler” reference states that in a first time period, until signal CHIL reaches a higher value, a current controller 140 adjusts the current flowing through the solenoid valve to a desired value IS1 prescribed by the control unit. The control unit opens switching means 110 when an upper current threshold is exceeded. Lower current threshold is fluid and is achieved via deactivation of switching means 110 for a specific time TP. When the current value is exceeded the switch opens and after the prescribed time TP the switch closes again. The current I through the solenoid valve oscillates between a prescribed upper threshold and a lower value. (Col. 4, lines 12 to 24).

Accordingly, the “Rehbichler” reference does not identically disclose (or even suggest) the feature *in which the duration of the time window starting from a starting value is increased if the current is smaller than the threshold value, and in which the duration of the time window is decreased if the current is greater than the threshold value.*

In contrast, the “Rehbichler” reference merely indicates that until signal CHIL reaches a higher value, the current flowing through the solenoid valve is adjusted to a desired value IS1 prescribed by a control unit such that when the current value is exceeded the switch opens and after a prescribed time TP the switch closes again. Nothing in the “Rehbichler”

reference identically discloses the foregoing claim feature *in which the duration of the time window starting from a starting value is increased if the current is smaller than the threshold value, and in which the duration of the time window is decreased if the current is greater than the threshold value*, as recited in the context of claim 91.

Accordingly, claim 91 is allowable, as are its dependent claims 92 to 96.

Claim 97 includes features like those of claim 91, and is therefore allowable for essentially the same reasons, as are its dependent claims 98 to 102.

With respect to paragraph ten (10), claims 83 to 90 were rejected under 35 U.S.C. § 102(b) as anticipated by United Kingdom Patent Application No. GB 2 311 559 (“Fischer”).

As regards anticipation law, the above discussion is referred to here.

Claim 86 was previously canceled without prejudice to facilitate matters.

While these rejections may not be agreed with (see the Amendment After Final previously filed), to facilitate matters, claims 83 to 85 and 87 to 90 are canceled without prejudice (claim 86 was previously canceled), since new claims 91 to 102 have been presented. It is therefore respectfully requested that these rejections be withdrawn.

As explained above, claim 91 is to a method of activating an electromagnetic consumer having a movable element, the method including ascertaining a switching instant within a time window, at which the movable element reaches a certain position, and specifying a duration of the time window so that a current which flows through the consumer during the time window does not exceed a threshold value, *in which the duration of the time window starting from a starting value is increased if the current is smaller than the threshold value, and in which the duration of the time window is decreased if the current is greater than the threshold value*.

In contrast the “Fischer” reference purportedly concerns a method and an apparatus for controlling an electromagnetic switching member with an excitation winding and a movable armature such that within a time window, a current is evaluated to detect a switching instant at which the armature reaches a new end position. The time window is enlarged when no reliable switching instant is detected within the time window. (Page 2, lines 1 to 7). Furthermore, the “Fischer” reference states that “[t]he measurement window, in particular the beginning FB of the window, cannot be chosen to be as large as desired, since the beginning FB of the window fixes the instant at which the current is regulated down to the holding current” and “[i]f this current is chosen to be too early, the valve does not switch sufficiently rapidly or even not at all.” (Page 6, lines 8 to 12).

Accordingly, the "Fischer" reference merely indicates that a measurement window cannot be as large as desired because the beginning FB of the window fixes the instant at which the current is regulated down to the holding current.

The applied reference therefore does not identically disclose (or even suggest) the feature *in which the duration of the time window starting from a starting value is increased if the current is smaller than the threshold value, and in which the duration of the time window is decreased if the current is greater than the threshold value*, as recited in the context of claim 91.

Accordingly, claim 91 is allowable, as are its dependent claims 92 to 96.

Claim 97 includes features like those of claim 91, and is therefore allowable for essentially the same reasons, as are its dependent claims 98 to 102.

It is therefore respectfully submitted that claims 91 to 102 are allowable.

Conclusion

It is therefore respectfully submitted that all of claims 91 to 102 are allowable. It is therefore respectfully requested that the rejections be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

Dated: 8/23/2005

Respectfully submitted,

By: Richard L. Mayer

Richard L. Mayer
Reg. No. 22,490

KENYON & KENYON
One Broadway
New York, New York 10004
(212) 425-7200

CUSTOMER NO. 26646

*By [Signature]
33,825
Hansen
O'NEILL*